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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,513	09/16/2003	Sandra M. Aris	0340-0001	1362
32256	7590	06/16/2006	EXAMINER	
REED SMITH LLP 1301 K STREET, N.W. SUITE 1100 EAST TOWER WASHINGTON, DC 20005			ELKINS, GARY E	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/662,513	ARIS ET AL.	
	Examiner Gary E. Elkins	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 29 March 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 and 37 is/are withdrawn from consideration.
- 5) Claim(s) 1-22 is/are allowed.
- 6) Claim(s) 32-36 and 38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 March 2006 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 29 March 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (1) New drawing sheets 2A-2C include new matter to this application. The construction shown in new figs. 2A and 2B illustrates formation of the changing area as a triangular section which was not described in the original specification. The construction of new fig. 2C illustrates a single continuous strap 410 connecting two series of holes 409 forming two hinge areas between the different sections. The original specification describes a finished hole placed in adjacent sides of each area 1, 3, 5 with a strap linking each area to form “a single hinge point”. New fig. 2C is clearly showing two hinge points if the strap is connected at each end to holes in both adjacent respective sections as opposed to a single hinge point as is described in the specification. (2) The added description in section 27 of the specification is considered new matter insofar as the drawings upon which the new description is based include constructions constituting new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. Claims 32-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. The amendment to claim 32 constitutes new matter. No description can be found in the original disclosure with respect to how the outside surfaces of the carrying case including the shoulder straps and handles “are always clean”. The description provides support for such surfaces being clean under particular circumstances, but does not define any disclosure that such surfaces are *always* clean.

3. Claims 32-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the outerside surfaces of the case are always clean. Since air contains dirt and normal use of the shoulder straps and contact with outside areas would naturally cause the case to get dirty, the description does not enable one of ordinary skill in this art to make and use the invention claimed.

4. Claims 32-36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claims 32-36 are unclear with respect to what structure is encompassed by the intended use of the case as defined in the last four lines of claim 32.

In claim 32, it is unclear whether the claim is positively defining the shoulder straps and handles or merely defining an intended use with shoulder straps and handles, i.e. the phrase “such that the outside surfaces of the carrying case, including shoulder straps and handles are always clean” does not appear to be positively claiming the shoulder straps and handles.

In claim 38, “a single hinge joint” appears to be a double inclusion of an element insofar as claim 1 previously defines first and second hinge joints. If an additional hinge joint is being set forth in claim 38, it is unclear from the description where the third single hinge joint is located.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 32, 35 and 36, as best understood in view of paragraphs 1-4 above, are rejected under 35 U.S.C. 102(b) as being anticipated by Lo Vico. Lo Vico discloses a carrying apparatus including a plurality of compartments and at least one point about which the device pivots to form a carrying case (fig. 6). With respect to claim 36, the case comprises closure means 14a, 14b for securing the case in a closed position. It is noted that no distinction is seen between the case claimed and that of Lo Vico as a result of the claimed intended use to “contain dirty surfaces”, i.e. the case of Lo Vico is considered capable of “containing dirty surfaces”. Also, with respect to claim 35, no distinction is seen between the case claimed and that of Lo Vico as a result of the claimed intended use of the compartments as a storage area and a changing area. The compartment 11b is considered capable of storing an article or articles and area 12a is considered capable of forming a mat for someone to stand or sit on when changing something.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 33, as best understood in view of paragraph 1-4 above, is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo Vico in view of either Wilkinson or Casey. Lo Vico discloses all structure of the claimed case except a hinge point comprising openings in each compartment and a joining device extending through each opening. Each of Wilkinson and Casey discloses formation of a fold-up mat construction using multiple pieces connected by seams formed by a hole in each section and a joining device extending through the holes. It would have been obvious to make the case of Lo Vico from multiple connected sections as taught by either Wilkinson or Casey to allow separation for cleaning or storage and to allow easier manufacture from continuous webs of material. It is noted that concept of forming the case from multiple pieces as opposed to one piece is considered *prima facie* obvious to one of ordinary skill in this art. The art is replete with examples of both single piece and multiple piece constructions where the multiple pieces are attached using connected seams.

9. Claim 34, as best understood in view of paragraphs 1-4 above, is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo Vico in view of either Ruddy or Alonso. Lo Vico discloses all structure of the claimed case except a hinge point comprising a sewn seam formed by a tab on each compartment. Each of Ruddy and Alonso discloses formation of a fold-up mat construction using multiple pieces connected by seams formed by sewing tabs connected to each

compartment. It would have been obvious to make the case of Lo Vico from multiple connected sections as taught by either Ruddy or Alonso to allow easier manufacture from continuous webs of material. Sewn seams are notoriously well known in this art.

***Allowable Subject Matter***

10. Claims 1-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Response to Arguments***

11. Applicant's arguments filed 29 March 2006 have been fully considered but they are not persuasive.

Initially, the typographical error designating claim 33 rather than claim 32 in paragraph 5 of the prior office action is noted. The remarks assert patentability over the patent to Lo Vico as a result of the error, but then proceed to describe the amendment of claim 32 and how such amendment assertedly overcomes the prior art rejection over Lo Vico. As such, it is believed that Applicant recognized that claim 32 as opposed to claim 33 was referred to in the paragraph 5 rejection and subsequently responded to this rejection.

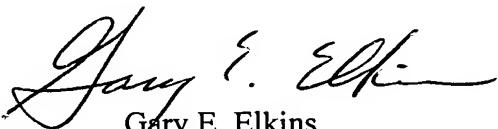
The remarks assert that the amendment to claim 32 defines over Lo Vico in that Lo Vico is capable of only being used in a manner which would soil clean surfaces of the case when folding and that the case of Lo Vico would be soiled by the ground during use. In response, claim 32, as best understood, merely defines an intended use of the case to contain dirty surfaces and that the case is capable of pivoting such that an outside surface is clean. No distinction is seen between the case claimed and that shown in Lo Vico as a result of the claimed intended use of the device since the case of Lo Vico is capable of holding dirty surfaces in the compartments

and is capable of folding such that an outside surface is relatively clean. The patentability of a product is not dependent upon its intended use. It is noted that the handles 16 in Lo Vico are considered shoulder straps as well insofar as one could position them over the shoulder with the case in one's armpit.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Gary E. Elkins  
Primary Examiner  
Art Unit 3727

gee  
11 June 2006